REMARKS

Claims 1-2 and 4-20 are pending in the instant application. Reconsideration is respectfully requested in light of the following remarks.

Claim 3 had previously been subjected to a Restriction Requirement under 35 U.S.C. §121 and 37 C.F.R. §1.141. The Examiner suggested that claim 3 specifically claimed antisense SEQ ID NOS: 11, 13-20, 25-28, 30, 32-42, 44, 45, 49-59, 64, 66-75, 78, 80, 82-85, 87 and 88, targeted to and modulating the expression of a nucleic acid encoding human FXR. The Examiner suggested that each sequence is structurally and functionally independent and distinct. It was further suggested that a search of more than one of the antisense sequences recited in claim 3 presented an undue burden on the Patent and Trademark Office due to the complex nature of the search and corresponding examination of more than one of the claimed sequences. The Examiner suggested that one antisense sequence was considered to be a reasonable number of sequences for examination. Further, the Examiner suggested that a search of databases produces a listing of references disclosing the sequence most similar to the query search. The Examiner indicated that prior art relating to

another query sequence would not be found in the same place and that a different listing of references must be generated and searched, thus making the restriction requirement proper.

Applicants traversed this restriction requirement in a reply filed June 2, 2003 which is believed to be fully responsive.

The Examiner is now suggesting that this reply was not fully responsive to the prior restriction requirement, in that 37 CFR 1.143 requires an election of the invention to be examined even though the requirement be traversed. The Examiner acknowledges that the prior Office action did not recite that claim 1, linked the inventions of claim 3. The Examiner has recited that the restriction requirement between the linked inventions is subject to the nonallowance of the linking claim 1.

MPEP §809 is quite clear, "[t]he linking claims must be examined with the invention elected, and should any linking claim be allowed, the restriction requirement must be withdrawn. Any claim(s) directed to the nonelected invention(s), previously withdrawn from consideration, which depends from or includes all the limitations of the allowable linking claim must be rejoined and will be fully examined for patentability. Where such

withdrawn claims have been canceled by applicant pursuant to the restriction requirement, upon the allowance of the linking claim(s), the examiner must notify applicant that any canceled, nonelected claim(s) which depends from or includes all the limitations of the allowable linking claim may be reinstated by submitting the claim(s) in an amendment. Upon entry of the amendment, the amended claim(s) will be fully examined for patentability. Applicants have previously canceled claim 3. Applicants believe that this cancellation of claim 3 renders the restriction requirement of the claim 3 sequences and the joinder of claim 1 to claim 3 for restriction purposes moot.

Furthermore, a linking claim is defined in MPEP §809 as occurring in a number of situations which arise in which an application has claims to two or more properly divisible inventions, so that a requirement to restrict the application to one would be proper, but presented in the same case are one or more claims (generally called "linking" claims) inseparable therefrom and thus linking together the inventions otherwise divisible. The Examiner appears to now suggest that claim 1 is a linking claim, which would be categorized as genus claims linking species claims. As claim 3 has been canceled there are no

species now claimed in which to link. However, assuming *arguendo*, that claim 1 is a linking claim to the species of claim 3, Applicants respectfully submit that more than one species of an invention, not to exceed a reasonable number, may be specifically claimed in one application under the Patent Rules, and that claim 2 would be considered generic to the several species of canceled claim 3.

Further yet, Applicants submit that 37 CFR 1.142 sets forth the proper requirements for restriction. 37 CFR 1.142 (a) requires that "if two or more independent and distinct inventions **are claimed** in a single application, the examiner in an Office action will require the applicant in the reply to that action to elect an invention to which the claims will be restricted". In the present application however, claim 3 has been canceled, and thus cannot be properly held to be subject to restriction as suggested by the Examiner.

All of pending claims of the instant application relate to antisense modulation of Human FXR expression. Further, a search of literature relating to a compound 8 to 50 nucleobases in length targeted to a nucleic acid molecule encoding human FXR would clearly reveal art relating to all of remaining pending

claims. Accordingly, Applicants submit that their response filed June 2, 2003 in reply to the previous office action was fully responsive and that no further restriction is required under the criteria as set forth by MPEP §803.

Reconsideration and withdrawal of this Restriction Requirement is therefore respectfully requested. In the event that a further election is required, Applicants elect to prosecute claims 1,2 and 4-20.

Respectfully submitted,

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